

REMARKS/ARGUMENTS

This is in response to the Office Action of May 22, 2008. In that Office Action, Claims 1, 4-12, and 14-27 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,746,215 to Manjarrez. Claims 13 and 28 were rejected under 35 USC 103(a) as being obvious over Manjarrez as modified by U.S. Patent No. 6,908,455 to Hajianpour.

At the outset, Applicants submit that the Office Action of May 22, 2008 is incomplete. In particular, the Office failed to take note of and answer or even address the substance of all of Applicants' arguments traversing the rejection of Claims 1, 4-12 and 14-27 under 35 USC 102(b). The MPEP provides under section 707.07(f) that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." That did not happen in the Office Action of May 22, 2008. In Applicants' Amendment and response filed May 1, 2008, Applicants presented three distinct and substantive arguments to support the withdrawal of the 35 USC 102(b) rejection over Manjarrez. However, only one of the three arguments was addressed.

Specifically, in the first full paragraph on page 7 of that response Applicants argued that Manjarrez does not disclose or suggest a side wall that includes a flexible retaining member that engages the hub. This argument was not noted or addressed substantively or otherwise by the Office. In addition, in the paragraph beginning on the bottom of page 8 of that response Applicants argued that Manjarrez does not disclose or suggest a multiple profile window that defines a fully enclosed aperture in the end wall of the housing. This argument also was not noted or addressed substantively or otherwise by the Office.

Applicants respectfully submit that both of the arguments identified above and presented in detail in Applicants' response of May 1, 2008, overcome the 35 USC 102(b) rejection over Manjarrez for all claims. Applicants respectfully request that these arguments be considered and addressed along with the claim amendments and further arguments presented herein. Furthermore, Applicants respectfully submit that if the next Office Action does not result in allowance of Claims 1, 4-12 and 14-27, that such an Office Action not be made Final, so as to provide Applicants with a meaningful opportunity to address the Office's response to the arguments previously presented but not addressed.

Regarding the claims, by this Amendment, independent Claims 1 and 11 have been amended.

Claim 1, as amended, is directed to a needle protector for use with a needle assembly that includes a flexible plastic tube attached to a needle hub and a needle mounted on the hub. The housing of the needle protector is defined by a plurality of side walls. The housing includes an open distal end and a proximal end. The proximal end has an end wall defining a fully enclosed aperture. The enclosed aperture is a multiple profile window adapted to selectively slidably receive and retain the tubing. At least one of the side walls includes a flexible retaining member spaced a sufficient distance from the distal end for retaining the hub of the needle assembly, such that when the needle hub is in the fully retracted position the piercing end is completely contained within the interior chamber. Further, at least one of the side walls has a longitudinally extending depression in the interior surface of the side wall, thereby defining an internal groove extending axially from the first open distal end to the open proximal end.

Claim 11, as amended, is directed to a needle protector for use with a needle assembly that includes a flexible plastic tube attached to a needle hub with a rib that extends outwardly and a needle mounted on the hub. The housing of the needle protector is defined by a plurality of side walls. The housing includes an open distal end and a proximal end. The proximal end has an end wall defining a completely enclosed aperture. The enclosed aperture defines a multiple profile window adapted to selectively slidably receive and retain the tubing. At least one of the side walls includes a flexible retaining member adapted for contacting the hub of the needle assembly and spaced a sufficient distance from the distal end such that when the needle hub is in the fully retracted position, the piercing end is completely contained within the interior chamber. Further, at least one of the side walls has a longitudinally extending depression in the interior surface of the side wall, thereby defining an internal groove extending axially from the first open distal end to the open proximal end.

Regarding Claims 1 and 11, it is the position of the Patent Office that Manjarrez discloses that "...the guiding ledges (54) of Manjarrez do define an internal groove..." Manjarrez identifies reference number 54 as "channel 54" (column 3, lines 45 and 53) and as "longitudinal slot 54" (column 4, lines 11-12). The area defined within the edges of channel 54 is actually a slot that is open from the internal cavity of the housing through to the outside surface of the side wall of the housing. By contrast, the axial groove recited in Amended Claims 1 and 11 is a depression in the interior surface of the side wall, open only towards the interior chamber and not open through the outside surface of the side wall. In other words, it is not a slot as shown in Manjarrez and certainly not a longitudinal slot open to the outside surface of the side wall as disclosed in Manjarrez. Moreover, the axial groove is not defined by ledges as is the case in

Manjarrez. The axially extending internal groove of Amended Claims 1 and 11 is provided to receive and accommodate the rib on the needle hub in the event that the needle hub is inverted as it enters the needle protector. The axially extending internal groove allows the needle hub to be retracted, even in the inverted position, into the needle protector without interference [00033]. By contrast, Manjarrez discloses that channel or longitudinal slot 54 is a means by which the actuating button 52 is able to move forward to make the device in a condition for use (column 3, lines 51-54; column 4, lines 10-12). In Manjarrez, inversion of the needle is not possible as the needle is fixed to the external actuating button. Thus, Manjarrez has no appreciation for needing an axial groove to allow the needle hub to be retracted in the inverted position, and for that reason does not disclose or suggest one.

Therefore, Applicants submit that for these reasons independent Claims 1 and 11 are not anticipated by Manjarrez. Applicants further submit that all of the arguments presented in the Applicants' response of May 1, 2008 as described therein continue to be valid reasons for withdrawal of the 35 USC 102(b) rejection over Manjarrez in view of presently amended Claims 1 and 11. For the sake of brevity, Applicants will not repeat in detail such arguments, but instead incorporate such arguments by reference and only summarize the same below. Briefly, as set forth in the response of May 1, 2008, Manjarrez does not disclose or suggest a need for a side wall that includes a flexible retaining member that is spaced a sufficient distance from the distal end such that the piercing end is fully enclosed within the interior chamber of the needle housing when the flexible retaining member engages the hub. As further set forth in the response of May 1, 2008, Manjarrez does not disclose or suggest a multiple profile window that defines a

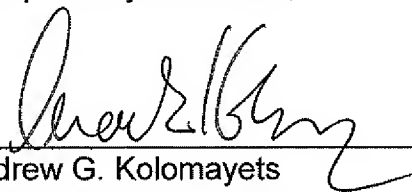
fully enclosed aperture in the end wall of the proximal end such that the tubing cannot be laterally displaced out of the window.

Claims 7, 9-10, 12-21, 24 and 26-28 depend from either independent Claims 1 or 11, and for the reasons set forth above, Applicants submit that dependent Claims 7, 9-10, 12-21, 24 and 26-28 are likewise not anticipated by Manjarrez.

Finally, should the Examiner still deem the claims unpatentable over Manjarrez, Applicants would welcome an opportunity to discuss the claims in a telephone interview to be conducted at the Examiner's convenience.

All of the pending Claims 1, 7, 9-21, 24 and 26-28 are believed to be in condition for allowance. Reconsideration and allowance of such claims are respectfully requested.

Respectfully submitted,



Andrew G. Kolomayets
Registration No. 33,723

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
200 West Adams Street - #2850
Chicago, IL 60606
(312) 236-8500